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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,404	09/08/2003	Gavin William Halbert	031749/268956	3177
826	7590	08/07/2006	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			ROBINSON, HOPE A	
		ART UNIT	PAPER NUMBER	
			1656	

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/657,404	HALBERT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hope A. Robinson	1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 31 May 2006.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1,2 and 4-25 is/are pending in the application.  
4a) Of the above claim(s) 16-25 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1,2 and 4-15 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 08 September 2005 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Application Status***

1. Applicant's response to the Office Action mailed December 29, 2005 on May 31, 2006, is acknowledged.

### ***Claim Disposition***

2. Claims 1-2 and 4-25 are pending. Claims 1-2 and 4-15 are under examination.

### ***Withdrawn-Objection to Claims***

3. Previous objection to claims are withdrawn by virtue of submission of an amendment.

### ***Withdrawn- Claims Rejection-35 USC § 102***

4. Previous rejection to claims under 35 U.S.C. 102 is withdrawn by virtue of submission of an amendment.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact

terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-2 and 4-14, are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed invention is directed to a non-naturally occurring receptor low density lipoprotein particle comprising at least one peptide component, said peptide component comprises at least a binding site for an Apo B protein receptor and wherein said peptide component is from 8 to 500 amino acid residues. The claims do not set forth a structure for the peptide and the claims recite the open language "comprising at least one peptide component", thus there's no upper limit. The claims encompass a genus of peptide components and analogues thereof for the residues recited in claim 2. It is noted that claims 14 and 15 recite a structure, however, independent claim 1 is devoid of one. Claim 14 is included in the rejection as the claim is also directed to "a dimer thereof" of the sequences recited in the claims. Therefore, the claims encompass a large variable genus of peptides. The specification fails to provide any additional representative species of the claimed genus to show that applicant was in possession of the claimed genus. A representative number of species means that the species, which are adequately described are representative of the entire genus. The written description requirement for a claimed genus may be satisfied through sufficient

description of a representative number of species by actual reduction to practice, disclosure of drawings, or by disclosure of relevant identifying characteristics, for example, structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus.

Accordingly, in the absence of sufficient recitation of distinguishing identifying characteristics, the specification does not provide adequate written description of the claimed genus. Therefore, the genus of claimed polypeptides encompasses widely variant species. Further, *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), states that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the *invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*" (See page 1117). The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed" (See *Vas-Cath* at page 1116). The skilled artisan cannot envision the detailed chemical structure of the encompassed genus of polypeptides, and therefore, conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it. The compound itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993).

Therefore, for all these reasons the specification lacks adequate written description, and one of skill in the art cannot reasonably conclude that the applicant had possession of the claimed invention at the time the instant application was filed.

6. Claims 1-2 and 4-14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the peptides set forth in SEQ ID NOS: 3, 4, 5, 6, 7 and 9 does not reasonably provide enablement for any peptide component thereof having Apo B binding site. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The enablement requirement refers to the requirement that the specification describe how to make and how to use the invention. There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is undue. These factors include, but are not limited to: Quantity of Experimentation Necessary; Amount of direction or guidance presented; Presence or absence of working examples; Nature of the Invention; State of the prior art and Relative skill of those in the art; Predictability or unpredictability of the art and Breadth of the claims (see *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). The factors most relevant to the instant invention are discussed below.

The amount of experimentation required to practice the claimed invention is undue as the claims encompass an unspecified amount of peptide components ( see

claim 1 for example). Further, the claims are directed to "analogues thereof and dimers thereof. No correlation is made between function and structure. The claims broadly read on any peptide component comprising at least one binding site for an Apo B protein receptor wherein the binding sequence of the peptide component is at least 70%, 80% or 90% identical to any Apo B protein binding sequence. Therefore, the claims encompass a genus of peptides which are needed demonstrated or described in the instant specification. A skilled artisan would recognize the unpredictability of testing the large variable genus of peptides encompassed in the claims with the expectation of finding ones that have the desired properties. This is merely an invitation to the skilled artisan to use the current invention as a starting point for further experimentation. Thus, undue experimentation would be required for a skilled artisan to make and/or use the claimed invention commensurate in scope with the claims.

Predictability of which potential changes can be tolerated in a protein's amino acid sequence and obtain the desired activity requires a knowledge of and guidance with regard to which amino acids in the protein's sequence, if any, are tolerant of modification and which are conserved (for example, expectedly intolerant to modification), and detailed knowledge of the ways in which the protein's structure relates to its function. The state of the prior art provides evidence for the high degree of unpredictability as stated above. While recombinant and mutagenesis techniques are known in the art, it is not routine in the art to screen large numbers of mutated proteins where the expectation of obtaining similar activity is unpredictable based on the instant disclosure. The amino acid sequence of a protein determines its structural and

functional properties, and predictability of what mutations can be tolerated in a protein's sequence and result in certain activity, which is very complex, and well outside the realm of routine experimentation, because accurate predictions of a protein's function from mere sequence data are limited, therefore, the general knowledge and skill in the art is not sufficient, thus the specification needs to provide an enabling disclosure.

The working examples provided do not rectify the missing information in the instant specification pertaining to the claimed variant. The nature and properties of this claim is difficult to ascertain from the examples provided as one of skill in the art would have to engage in undue experimentation to construct the variants of the claimed invention and examine the same for function. Thus the specification does not provide support for the broad scope of the claims. The issue in this case is the breadth of the claims in light of the predictability of the art as determined by the number of working examples, the skill level artisan and the guidance presented in the instant specification and the prior art of record. This make and test position is inconsistent with the decisions of *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) where it is stated that "... scope of claims must bear a reasonable correlation to scope of enablement provided by the specification to persons of ordinary skill in the art...". Without sufficient guidance, determination of having the desired biological characteristics is unpredictable and the experimentation left to those skilled in the art is unnecessarily and improperly extensive and undue. See *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). Thus, for all these reasons, the specification is not

considered to be enabling for one skilled in the art to make and use the claimed invention as the amount of experimentation required is undue.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 1-2 and 4-15 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter, which applicant (s) regard as their invention.

Claim 1 lacks clear antecedent basis for "from 8 to 500 amino acid residues" because the instant specification does not provide support for this phrase. It is noted that the originally filed claims recited this language, thus, it is suggested that the specification is amended to disclose this information. The dependent claims hereto are also included as they do not rectify the situation.

#### ***Response to Arguments***

8. The response filed on May 31, 2006 has been considered. Note that new grounds of rejections have been instituted under 35 U.S.C. 112, first and second paragraphs for the reasons stated above.

#### ***Conclusion***

9. No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope A. Robinson whose telephone number is 571-272-0957. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr, can be reached at (571) 272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hope Robinson, MS  
Patent Examiner  
8/11/06

HOPE ROBINSON  
PATENT EXAMINER